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No. 916

IN THE

Supreme Court of the United States

OCTOBER TERM, 1962

WATKINS PRODUCTS, INC., formerly known as THE J. R. WATKINS COMPANY,

Petitioner,

vs.

SUNWAY FRUIT PRODUCTS, INC.,

Respondent.

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SEVENTH CIRCUIT

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To the Honorable, the Chief Justice, and Associate Justices of the Supreme Court of the United States.

Petitioner, Watkins Products, Inc., prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Seventh Circuit, entered December 14, 1962, which reversed a judgment for petitioner entered by the United States District Court for the Northern District of Illinois on January 31, 1962.

The judgment of the District Court was rendered upon the complaint of petitioner to review and reverse a decision of the Trademark Trial and Appeal Board of the Patent Office which had cancelled trademark registrations of petitioner on the Supplemental Register of the Patent Office for petitioner's trademarks "FRESH-AID" and

"FRESH-ADE" for liquid beverage base. Said judgment of the District Court had reversed the cancellation of petitioner's registration for "FRESH-AID" only, the mark and registration for "FRESH-ADE" having been abandoned.

The District Court judgment also dismissed a counterclaim by respondent charging petitioner, among other things, with infringement of the former's mark "FRESHIE" and unfair competition by use of the mark "FRESH-AID".

The judgment of the Court of Appeals reversed the judgment of the District Court and remanded with instructions to the District Court to dismiss the complaint and to enjoin petitioner from its use of "FRESH-AID" but no accounting was ordered under the circumstances of the case.

CITATIONS OF OPINIONS BELOW.

The opinion of the United States Court of Appeals for the Seventh Circuit (December 14, 1962) has not been reported officially but it has been reported in *Watkins Products, Inc.* v. *Sunway Fruit Products, Inc.* (C A 7 Dec. 14, 1962), 135 USPQ 14 and a copy of said opinion is annexed hereto as Appendix "A".[1] The Memorandum Decision and Findings of Fact and Conclusions of Law of the District Court for the Northern District of Illinois, Eastern Division, has been reported in *Watkins Products, Inc.* v. *Sunway Fruit Products, Inc.*, (D.C.N.D.E.D. Ill.) 133 USPQ 136 and a copy of said decision is annexed hereto as Appendix "B".

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[1] References hereinafter to the "Appendix" are to the appendix of this petition; references to "Pls. App." and "Defs. App." are to the appendix record below, nine copies of which have been filed in accordance with paragraph 4 of Rule 21 of this Court.

The decision of the Trademark Trial and Appeal Board has been reported in *Sunway Fruit Products, Inc.* v. *J. R. Watkins Company*, (TMTAB Oct. 12, 1960) 127 USPQ 171 and a copy of said decision is annexed hereto as Appendix "C".

JURISDICTION.

The jurisdiction of this Court is invoked under 62 Stat. 928, 28 U.S.C. §1254(1) and 62 Stat. 961 as amended, 28 U.S.C. §2101(c).

QUESTIONS PRESENTED.

The questions presented are:

1. May a Court of Appeals vest the owner of the trademark "FRESHIE" with exclusiveness in the generic word "Fresh" as applied to a beverage base by reversing a District Court which had refused to do so and had held that the only similarity between petitioner's undisputedly descriptive trademark "FRESH-AID" (the phonetic equivalent of "Fresh-Ade" meaning a fresh drink) and "FRESHIE" was said word "Fresh" in effect in the public domain and not the subject of exclusive appropriation?

2. May a Court of Appeals reverse a District Court's finding of no confusion between two trademarks in that the only similarity between the petitioner's accused trademark and that of the respondent accuser involves a generic word which in effect resides in the public domain and the accused trademark is undisputedly merely descriptive of the nature and quality of the goods, regardless of whether the trademark of the accuser be deemed descriptive as the District Court held or merely suggestive as was held by the Court of Appeals?

3. May a Court of Appeals reverse a District Court's finding that the only similarity between an accused's trademark and that of an accuser in effect resides in the public domain and is not the subject of exclusive appropriation, the Court of Appeals basing its reversal of the District Court solely upon the fact that the District Court was bound by and could not reverse a previous decision of the Patent Office Trademark Trial and Appeal Board in a cancellation proceeding holding the marks to be confusingly similar despite the obvious fact and overwhelmingly clear and convincing evidence that the only similarity between the marks was in the public domain?

4. May the Court of Appeals order an injunction restraining the further use of a merely descriptive mark such as that of the petitioner and thus is in effect in the public domain regardless of whether or not the respondent accuser's mark is merely suggestive rather than descriptive?

5. May a Court of Appeals penalize and interfere with the free exercise of petitioner's right to seek a review in the Supreme Court by imposing as a condition to the continuance of a stay of mandate pending a petition for certiorari that petitioner account for profits during the continuance of the stay if the Supreme Court denies the petition despite the fact the Court of Appeals had reversed the District Court and ordered an injunction but without an accounting in view of the circumstances of the case?

STATUTES INVOLVED.

The statutes involved are: Appeal to courts; review; 60 Stat. 435 as amended, 15 U.S.C. §1071; Civil action in case of interference, 66 Stat. 803, 35 U.S.C. §146; Rules

of Civil Procedure for District Courts, 62 Stat. 961 as amended, 28 U.S.C. §2072; Rule 52(a) of the Federal Rules of Civil Procedure, Findings by the Court, 28 U.S.C.; Review-miscellaneous provisions, determination, 62 Stat. 963, 28 U.S.C. §2106. They are annexed hereto as Appendix "I".

STATEMENT.

This action was instituted in the District Court pursuant to the provisions of Title 35 USC Sec. 146, to review the decision of the Trademark Trial and Appeal Board of the Patent Office rendered on October 12, 1960, in a Cancellation Proceeding No. 7293, entitled Sunway Fruit Products vs. The J. R. Watkins Company, 127 USPQ 171 (TMTAB October 12, 1960) (Appendix C) wherein said board ordered cancellation of petitioner's trademark registrations on the Supplemental Register for "FRESH-AID" and "FRESH-ADE" for liquid beverage base held by said board to be confusingly similar to respondent's trademark and registration therefor for "FRESHIE" for powdered beverage base. Respondent Sunway Fruit Products filed a counter-claim alleging that its mark "FRESHIE" had acquired a secondary meaning (Defs. App. 7) by extensive use and advertising and charging petitioner with trademark infringement, unfair competition, unjust enrichment and dilution by reason of petitioner's use of the trademark "FRESH-AID" ("Fresh-Ade" having been discontinued after initial token use by petitioner).

The District Court found (Appendix B) respondent's "FRESHIE" to be descriptive, petitioner's "FRESH-AID" to be also descriptive by virtue of being on the Supplemental Register, that the only thing in common between the marks was the generic word "Fresh" in common use descriptively, which no one could pre-empt

and which was not likely to be considered as a source indication by the public and hence the marks were not confusing. The District Court further found that no secondary meaning had been acquired in "FRESHIE," reversed the decision of the Patent Office Trademark Trial and Appeal Board, ordered petitioner's registration for "FRESH-AID" restored to the Supplemental Register and dismissed respondent's counter-claim.

There was new evidence (Pls. App. 1-62) before the District Court which was not before the Patent Office Board. This included admissions by respondent that its "FRESHIE" trademark meant "fresh" (Defs. App. 22 and 89); the admissions by respondent when it was seeking its registration for "FRESHIE" in order to overcome a rejection by the Patent Office based on a prior registration for "FRESH-UP" wherein respondent represented in effect that the term "fresh" was in the public domain in that it was suggestive of freshness of the product, had been used and registered by so many in the food and beverage field that the ordinary purchaser would not be likely to consider it a source indication (PX 1, Pls. App. 13; Defs. App. 18); the admissions of respondent's Executive Vice President pertaining to the sparsity of respondent's "FRESHIE" advertising, declining use (PX 47, Pls. A. 61) and loss of good will before the advent of "FRESH-AID" (Pls. App. 1-12) from which the District Court made its Finding No. 11 (Defs. App. 113-114) and the certified status copies (PX 2-46, PA 18-60) of other trademark registrations for marks including "fresh" all of which pertain to the common usage of "fresh" in the public domain and lack of secondary meaning in "FRESHIE."

More specifically the District Court found (Appendix B) (Defs. App. 112-115) that respondent itself repre-

sented to the Trademark Trial and Appeal Board when it sought cancellation of petitioner's FRESH-AID registration that "FRESHIE and FRESH stimulate an identical mental association" (Finding No. 7); that said board made no finding that "FRESHIE" had acquired a secondary meaning or was distinctive (Finding No. 8); that "fresh" in various combinations is used and registered widely as a part of trademarks on food and beverage products and an ordinary purchaser would not attribute such use as a source indication, is generically descriptive and in common use (Findings Nos. 9 and 10); that respondent had an ad for "FRESHIE" in 1948 in the comic section of the Chicago American and in certain other states and did a small amount of radio advertising in Minnesota just prior to the adoption (1957) of petitioner's FRESH-AID; that the advertising of "FRESHIE" was otherwise nominal and according to respondent's Executive Vice President was purposely so because they wanted to crawl before they walked; that the sales of "FRESHIE" started to diminish in 1949 many years prior to 1958 when Watkins "FRESH-AID" product entered the field commercially and the downward trend continued due to causes other than competition from petitioner's mark; that respondent lost many important customers and many were sold considerable quantities of "FRESHIE" during one season and not since long before the advent of "FRESH-AID" and that it was obvious that no secondary meaning had been acquired in "FRESHIE" (Finding No. 11); that no actual confusion was shown and none appeared likely (Finding No. 12); that the suffix "ie" forms the single word "FRESHIE" and by being added to the word "fresh," seems to be a diminutive form or in the nature of a diminutive form of the latter; that in common usage, at least, hints at an effort to appeal to children or to the mothers of

children, or to, perhaps, the gay young people seeking refreshment by way of soft drinks (Finding No. 13); "FRESH-AID" has a full word "aid" attached to the full word "fresh" by a hyphen, forming a compound word. "Aid" has no similarity to the suffix "ie," used by respondent, and has no connotation or pronunciation which could be confusingly similar to "FRESHIE." There is no confusing similarity between the marks in appearance, sound or meaning and there is nothing about the marks which could reasonably be said to cause confusion as to the source of the products or the likelihood of confusion. In fact, the contrary appears (Findings Nos. 14 and 15); that use of "Watkins" before "FRESH-AID" precluded confusion and in the display of Sunway's powdered products in opaque packages, colored according to flavor, bearing its trademark "FRESHIE," and the display of Watkins liquid concentrate, colored according to flavor, and contained in comparatively large, flat, transparent bottles bearing labels reciting "Watkins FRESH-AID," there seems to be no similarity or reasonable cause for or likelihood of confusion (Findings Nos. 16 and 17).

From the foregoing findings the District Court concluded that the admittedly descriptive mark "FRESH-AID" on the Supplemental Register was not confusing with "FRESHIE" which, although registered on the Principal Register, was inherently weak and descriptive and a court was not prevented from considering such weakness, citing *John Morrell & Co.* v. *Reliable Packing Co.* (7 Cir. 1961), 295 F. 2d 314, 316 (Def. App. 115-116). The District Court in considering the question of confusion followed the doctrine expressed in *Solventol Chemical Products Inc.* v. *Langfield*, 134 F. 2d 899, and other cases holding that where marks as a whole are suggestive with suggestive or descriptive portions, especially in

common use, such portions are given relatively little weight on the question of confusion. The District Court held that the Trademark Trial and Appeal Board having failed to consider the inherent weakness of respondent's "FRESHIE" and having ignored the doctrine expressed in the cases just referred to should be reversed especially since "FRESHIE" had not acquired a secondary meaning either as a whole or in its "Fresh" portion which constituted the only similarity between the marks involved and the suffixes "ie" and "aid" differed in appearance, sound and meaning (Defs. App. 115-118).

The respondent appealed to the Court of Appeals, 7 Cir., from the judgment of the District Court reversing the Patent Office Trademark Trial and Appeal Board and dismissing the counter-claim, and on December 11, 1962, the Court of Appeals rendered its decision (Appendix A) holding that the District Court was bound by and required to accept the decision of the Trademark Trial and Appeal Board that confusion was likely between petitioner's "FRESH-AID" trademark and respondent's "FRESHIE" trademark, the Court of Appeals following the case of *Esso Standard Oil Company v. Sun Oil Company*, D.C. Cir., 229 F. 2d 37.

The Court of Appeals did not challenge the District Court's findings that the mark "FRESHIE" had not acquired a secondary meaning and held that said mark was merely suggestive and not descriptive and as a suggestive mark rather than a descriptive one it did not have to be endowed with a secondary meaning to be enforceable.

In determining that respondent's "FRESHIE" was merely suggestive rather than descriptive, the Court of Appeals followed the test which it laid down in *Inde-*

pendent Nail & Packing Co., Inc. v. *Stronghold Screw Products Inc.*, 205 F. 2d 921, 924, 925, wherein it had held that in order for a mark to be descriptive it must be so overwhelmingly descriptive that when a purchaser sees the mark on a package it will inform him as to the contents and thus, in effect, it must be at least an apt name of the goods. Short of that degree of descriptiveness the mark was regarded as merely suggestive. The Court of Appeals did not consider the question of whether petitioner's accused mark "FRESH-AID" met the test of descriptiveness which it laid down for respondent's mark "FRESHIE." The Court of Appeals held that it agreed with the decisions in *Skinner Mfg. Co.* v. *Kellogg Sales Co.*, 8 Cir., 143 F. 2d 895, and in *Kellogg Company* v. *National Biscuit Company*, 305 U.S. 111, but that they were not authority for holding the mark "FRESHIE" to be descriptive. It did not consider the effect of these decisions where the accused mark "FRESH-AID" is descriptive. It reversed the District Court on the basis that "FRESHIE" was not descriptive but merely suggestive and did not require a secondary meaning. Its opinion (Appendix A) made no mention of the fact that respondent itself had claimed in its counter-claim (Defs. App. 7) that "FRESHIE" had acquired a secondary meaning which the unchallenged Finding No. 11 (Defs. App. 113-114) of the District Court expressly found had not been done.

REASON FOR GRANTING THE WRIT

The writ should be granted because the first, second and fourth questions which the petition presents have been answered in the negative both by this Court and by other Courts of Appeals.

For example, regardless of whether the trademark "FRESHIE" of respondent be deemed descriptive or

merely suggestive, the factor of over-riding importance is that petitioner's trademark "FRESH-AID" on the Supplemental Register of the Patent Office as a descriptive mark as the phonetical equivalent of "FRESH-ADE," is descriptive or it would not be on the Supplemental Register. Its descriptive character has not been disputed anywhere in these proceedings. Webster's New International Dictionary, Second Edition, defines "Ade" as:

> "b. Result or product (of an action); thing made (by a certain act or process or from certain materials); as in lemonade, marmalade, orangeade, torsade, arcade, etc.
>
> • • • "A drink made from the juice of (usually citrus) fruit mixed with water and sweetened; as lime or grape ade."

Hence petitioner's accused mark "FRESH-AID" is descriptive of a fresh ade or drink. Petitioner's product, a liquid beverage base, is actually a concentrated drink or ade to which water is added to make a fresh drink or fresh ade of citrus flavor. Except for some secondary meaning that petitioner may acquire by usage in "FRESH-AID" rendering it distinctive of petitioner's goods it merely describes petitioner's goods.

This Court has repeatedly held that the use of a similar name by another to truthfully describe his own products does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product. The cases where this Court has so held, *indicating that the factor of over-riding importance is the descriptive character of the accused mark*, have been collected in *Skinner Mfg. Co. v. Kellogg Sales Co.*, 143 F. 2d. 895, 898-899, 62 USPQ 324 (8 Cir.):

"The use of a similar name by another to truthfully describe his own product does not constitute a legal or moral wrong, even if its effect be to cause the public to mistake the origin or ownership of the product. *Canal Co.* v. *Clark*, 13 Wall. 311, 323, 327, 20 L.Ed. 581; *Standard Paint Co.* v. *Trinidad Asphalt (Mfg.) Co.*, 220 U.S. 446, 453, 31 S.Ct. 456, 55 L.Ed. 536; *Howe Scale Co.* v. *Wyckoff, Seamans & Benedict*, 198 U.S. 118, 140, 25 S.Ct. 609, 49 L.Ed. 972. *William R. Warner & Co.* v. *Eli Lilly & Co.*, 265 U.S. 526, 528, 44 S.Ct. 615, 616, 68 L.Ed. 1161. See also *Elgin National Watch Co.* v. *Illinois Watch-Case Co.*, 179 U.S. 179 U.S. 665, 673, 21 S.Ct. 270, 45 L.Ed. 365; *Kellogg Co.* v. *National Biscuit Co.*, 305 U.S. 111, 116, 117, 59 S.Ct. 109, 83 L.Ed. 73; *Armstrong Paint & Varnish Works* v. *Nu-Enamel Corp.*, 305 U.S. 315, 334, 335, 59 S.Ct. 191, 83 L.Ed. 195."

Respondent's "Freshie" is also descriptive. The foregoing cases also indicate that the test of descriptiveness used by the Court of Appeals in determining whether respondent's mark "FRESHIE" was descriptive or merely suggestive was erroneous as requiring the mark to be in effect the name or an apt name of the goods in order to be descriptive. The Court of Appeals followed the test which it laid down in *Independent Nail & Pack Co.* v. *Stronghold Screw Products* (7 Cir. 1953), 205 F. 2d 921, 925, which required the mark when used on a package to reveal the contents, in order to be descriptive. *This would rule out such generic words descriptive of quality or characteristics as were held by this Court to be descriptive* in *Standard Paint Co.* v. *Trinidad Asphalt Mfg. Co.*, 220 U.S. 446, holding 'Ruberoid' and 'Rubberoid' to be descriptive as applied to roofing, which was not even made of rubber but merely had as one of its attributes a rubber-like quality. In that case, 220 U.S. 446, 453-455, this Court said on page 454:

"But two qualifying rules were expressed as follows: 'No one can claim protection for the exclusive use of a trade-mark or trade-name which would practically give him a monopoly in the sale of any goods other than those produced or made by himself. If he could, the public would be injured rather than protected, for competition would be destroyed. Nor can a generic name, or a name merely descriptive of an article of trade, of its *qualities*, ingredients or *characteristics*, be employed as a trade-mark and the exclusive use of it be entitled to legal protection." (Emphasis ours).

The Court of Appeals decision in this respect was also in conflict with the following decisions of this Court:

In *Manufacturing Co.* v. *Trainer*, 101 U.S. 51, 55, this Court held that words denoting quality were available to all; and in referring to descriptive symbols "A.C.A." which formed a part of each mark involved, the court said on page 55:

"Used in that device to denote only quality, and so understood, they can be used by others for a similar purpose equally with the words 'superior' of 'superfine' or other words or letters or figures having a like signification."

In *Lawrence Mfg. Co.* v. *Tennessee Mfg. Co.*, 138 U.S. 537, 549, the Supreme Court said:

"Nothing is better settled than that an exclusive right to the use of words, letters or symbols, to indicate merely the quality of the goods to which they are affixed, cannot be acquired."

Thus both of the marks "FRESHIE" and "FRESH-AID" hereinvolved are descriptive according to the decisions of this Court.

THE MARKS ARE NOT CONFUSING EVEN IF IT BE ASSUMED THEY ARE MERELY SUGGESTIVE.

Even if it be assumed arguendo that both "FRESHIE" and "FRESH-AID" are merely suggestive rather than descriptive the decision of the Court of Appeals would be in conflict with the decisions of the Court of Customs and Patent Appeals and other Courts of Appeals. Such decisions have been collected in *May Department Stores v. Kenya* (CCPA 1956) 234 F. 2d 870, 872 wherein that Court held "Aristosheen" not confusing with "Aristocrat" because the common prefixes were derived from the Greek word "aristos" meaning "best". That Court, after referring to the cases pertaining to the rule against dissecting marks for purposes of comparison, on page 872 said:

> "Nevertheless, it is proper to note that it has frequently been held that marks whose initial syllable or syllables are the same will not be regarded as confusingly similar if the syllable or syllables in question have a descriptive *or suggestive* connotation and the remaining portions of the marks are clearly distinct. Examples of such cases, with the marks involved, are as follows:
>
> "*Alumatone Corp. v. Vita-Var Corp.*, 37 C.C.P.A. (Patents) 1151, 183 F. 2d 612, 86 U.S.P.Q. 359 (Alumatone and Alumikote); *Kraft Walker Cheese Co. v. Kingsland*, 75 F. Supp. 105, 75 U.S.P.Q. 318 (Vegemite and Vegex); *Miles Laboratories, Inc. v. Foley & Co.*, 32 C.C.P.A. (Patents) 714, 144 F. 2d 888, 63 U.S.P.Q. 64 (Vitamiles and Vitabuild); *Solventol Chemical Products, Inc. v. Langfield*, 134 F. 2d 899, 57 U.S.P.Q. 210 (Solventol and Solvite); *Steem-Electric Corp. v. Herzfeld-Phillipson Co.*, 118 F. 2d 122, 48 U.S.P.Q. 92 (Steam-O-Matic and Steem-Electric); *Vick Chemical Co. v. Kerfoot & Co., Ltd.*,

23 C.C.P.A. (Patents) 752, 80 F. 2d 73, 27 U.S.P.Q. 393 (Vapex and Vaporub); *Thomas Kerfoot & Co., Ltd.* v. *Louis K. Liggett Co.*, 67 F. 2d 214, 21 U.S.P.Q. 503 (Vapure and Vapex)." (Emphasis ours)

The *Alumatone* case, 183 F. 2d 612 involving common suggestive prefixes "Alum"; the *Miles Laboratories* case 144 F. 2d. 888 involving common suggestive prefixes "Vita", the *Vick Chemical Co.* case, 80 F. 2d 73 involving the common suggestive prefixes "Vap" were cases in the Court of Customs and Patent Appeals.

The *Solventol* case, 134 F. 2d 899 involving suggestive marks with the common descriptive prefixes "Sol" was in the Sixth Circuit Court of Appeals and that Court there reversed the District Court because of the latter's failure to reverse the Patent Office because the Patent Office was manifestly wrong on the question of confusion *by not giving effect to what was in the public domain.* It is interesting to note that the Court of Appeals there referred to both marks "Solventol" and "Solvite" as a whole as *suggestive* with descriptive prefixes "Sol", but not confusing, the court saying on page 903:

> "In our opinion the trial court failed to give effect to the rule that the adoption of a *suggestive* mark by one trader, will not preclude any other trader from employing another mark of equal *suggestiveness* provided such other mark be not deceptively similar, when descriptive letters, syllables or phrases are eliminated. *Bartlett Company* v. *Arbuckle Bros.*, 52 App. D.C. 267, 285 F. 1001." (Emphasis ours)

Considering the third question presented, this question should be answered in the negative according to applicable decisions of this Court, other Courts of Appeal

and even the same Court of Appeals that rendered the decision here involved.

The Court of Appeals in its decision (Appendix A4a) herein followed the case of *Esso Standard Oil Company* v. *Sun Oil Company*, D.C. Cir., 229 F. 2d 37 wherein the marks involved "Univis" and "Sunvis" were only slightly suggestive as compared with the marks "FRESHIE" and "FRESH-AID" hereinvolved which are descriptive, at least as to "FRESH-AID" and as to "FRESHIE" it is at least highly suggestive. Thus the Court of Appeals here if it deemed the marks involved to be merely suggestive and not descriptive it should have followed the *Solventol* case in the Sixth Circuit, *Solventol Chemical Products, Inc.* v. *Langfield*, (6 Cir. 1943) 134 F. 2d 899, 902-903 involving the marks "Solventol" and "Solvite", previously discussed herein in connection with the first two questions presented. In that case, 134 F. 2d 899, 902-903, as heretofore pointed out the Sixth Circuit Court of Appeals reversed the District Court for not reversing the Patent Office because both the District Court and the Patent Office tribunal failed to give effect to what was in the public domain and failed to recognize the rule that one trader may not preclude another from using a mark of equal suggestiveness (p. 903).

The Court of Appeals, in its decision (Appendix A4a) herein, following the *Esso* case, 229 F. 2d 37, which in turn followed *Morgan* v. *Daniel*, 1894, 153 U.S. 120, 125 and *Abbot* v. *Coe*, 1939, 109 F. 2d 449, 451, not only failed to consider that the marks involved in the *Esso* case were neither descriptive as here nor even highly suggestive but only slightly suggestive and that only after considerable reflection, but it also failed to consider that there was involved here not merely a preponderance of

evidence (as in those cases which were followed) manifesting error on the part of the Patent Office tribunal. Instead the evidence here in this case is overwhelmingly clear and convincing that the only thing in common between the marks hereinvolved is in the public domain.

MORE THAN PREPONDERANCE OF EVIDENCE INVOLVED HERE.

Respondent itself in seeking its registration for "FRESHIE" over a previous registration for another trademark involving "Fresh" represented that "Fresh" was in common use for like goods and was in effect in the public domain and not a source indication (Pls. App. 13-17). Respondent's own argument before the Patent Office board was to the effect that its "FRESHIE" means "fresh" (Defs. App. 22). Respondent's own executive vice-president testified (Defs. App. 89) that its "FRESHIE" means "fresh" and is a drink. Petitioner's Exhibits 2-46, Pls. App. 18-60, show common usage of the term "Fresh" as a part of trademarks in the food and beverage field.

Considering the Fourth Question presented, this was previously discussed in connection with the First and Second Questions presented but in addition to the reasons there mentioned it is submitted that the Court of Appeals should not have ordered the injunction on the basis of the Patent Office tribunal's finding of confusion even if there were only a preponderance of the evidence indicating error in the conclusions of said board instead of clear and convincing evidence to that effect, because said board was only determining the question of the right of petitioner to registration rather than the right of petitioner to use its mark "FRESH-AID". The Court of Appeals which ordered such injunction has heretofore

clearly distinguished between the right to registration and the right to use as it did in the case of *Merrick et al v. Sharp & Dohme, Inc.*, (7 Cir.) 185 F. 2d 713, 717, 88 U.S.P.Q. 145, 147. It was only the right to register that the Patent Office board was determining in any event and not the right to use which is involved where an injunction is ordered.

Considering the Fifth Question presented, this should be answered in the negative because the Court of Appeals in its decision did not award an accounting under the circumstances of this case as was proper considering the *unchallenged* finding of fact No. 11 (Appendix B43a) of the District Court that respondent's sales diminished long before petitioner entered the field and other facts indicating that respondent could not have been damaged. Nevertheless the Court of Appeals on respondent's motion conditioned the stay of mandate ordering the injunction upon petitioner accounting to respondent for its profits for the sale of "FRESH-AID" and "FRESH-ADE" during the continuance of the stay if the petition for certiorari is denied. It is submitted that such action of the Court of Appeals in so conditioning the stay of mandate on an accounting for profits injected a factor inconsistent with the decision of the court in the case which interfered with the free exercise of petitioner's right to seek a review in the Supreme Court. Such condition of the stay of mandate was allowed by the Court of Appeals over the objection of petitioner.

A further and concluding reason for granting the writ is that all of the questions presented, One to Five, inclusive, should be further answered in the negative because the findings of the District Court (Appendix B11a-18a) as to the descriptive character of the marks involved

and the lack of likelihood of confusion therebetween giving due effect to what is in the public domain were based on the trial judge's exercise of his judicial function of review and such findings should not be set aside unless clearly erroneous. Rule 52(a) Fed. R. Civ. P. (Appendix 1 29a) The Court of Appeals here has itself recognized this principle in *Fuller Products Co. v. Fuller Brush Co.*, 299 F. 2d 772, 776 (7 Cir. 1962) cert. den. 370 U.S. 923, where it sustained the reversal by the District Court of the Trademark Trial and Appeal Board of the Patent Office board in an equally erroneous determination of the likelihood of confusion, said Court of Appeals saying on page 776:

> "That finding (by the Patent Office Board) was expressly found to be in error by the District Judge, who found, on clear and convincing evidence that 'expansion of trade' by The Fuller Brush Company to vitamins was not a natural one. On the record before us, this Court cannot rule that the District Court's finding was clearly erroneous, Federal Rules of Civil Procedure 52(a)." (Words in parenthesis ours)

For the foregoing reasons the petition for writ of certiorari should be granted.

Respectfully submitted,

THEODORE W. MILLER
Attorney for Petitioner.

Dated: March 8, 1963

APPENDIX A.

(Decision of C.A. 7th Cir.)

In the

UNITED STATES COURT OF APPEALS

For the Seventh Circuit

No. 13736 SEPTEMBER TERM AND SESSION 1962

WATKINS PRODUCTS, INC., formerly known as THE J. R. WATKINS COMPANY,
Plaintiff-Appellee,
v.
SUNWAY FRUITS PRODUCTS, INC.,
Defendant-Appellant.

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

December 14, 1962

Before DUFFY, CASTLE and SWYGERT, *Circuit Judges.*

DUFFY, *Circuit Judge.* Plaintiff's complaint herein asked the District Court to reverse the Trademark Trial and Appeal Board of the Patent Office, which canceled a trademark registration of plaintiff on the Supplemental Register. Defendant filed a counterclaim charging plaintiff, among other things, with trademark infringement and unfair competition. The District Court reversed the decision of the Patent Office Trademark Trial and Appeal Board, ordered plaintiff's registration restored to the Supplemental Register, and dismissed the counterclaim.

Defendant is a small family-owned corporation. Its predecessor, doing business as Sunway Fruit Products,

in July, 1944, adopted and began using the trademark FRESHIE for a beverage base for various flavored soft drinks. On December 31, 1946, defendant acquired all rights to the trademark FRESHIE, and the appurtenant good will. Defendant and its predecessor have made continuous use of FRESHIE for its beverage base throughout the United States and Canada. The sale of FRESHIE beverage base represented 95% of the defendant's business.

The greater part of defendant's sales of its FRESHIE beverage base is by means of house-to-house sales. It is also sold as a premium product for special promotion programs. Commensurate with its comparatively small size, defendant has spent substantial sums in advertising and promoting its FRESHIE beverage base. Defendant has conducted some radio and newspaper advertising, including radio advertising in Minnesota where plaintiff's principal place of business was located at the time plaintiff selected its trademark FRESH-AID for its beverage base product.

Plaintiff is a Minnesota corporation. It engages in the manufacture and sale of a variety of products for home and personal use. The bulk of plaintiff's sales is through house-to-house route sales.

For many years prior to 1957, plaintiff marketed a beverage base under its "Watkins" name. In 1957, plaintiff decided to adopt a new name for its beverage base. Plaintiff selected the marks FRESH-AID and FRESH-ADE. It did so in spite of the fact a trademark search report disclosed defendant's prior registration of the trademark FRESHIE. The front label on plaintiff's product, in addition to the trademark FRESH-AID, shows the name Watkins in substantially smaller letters and a different script. The back label bears only the trademark FRESH-AID underneath which appears the list of ingredients and directions, being twenty-one lines of printed matter. At the extreme bottom in very small type appears "Watkins Products, Inc." and four of its business addresses.

Plaintiff's sale of its FRESH-AID base constitutes about 4% of its business. This is double the volume of sales prior to its use of the trademark FRESH-AID.

On December 9, 1957, plaintiff applied to register FRESH-AID and FRESH-ADE as trademarks in the United States Patent Office. Registration upon the Principal Register was refused, but on January 20, 1959 and on February 3, 1959, plaintiff succeeded in registering its marks on the Supplemental Register.

When defendant learned from the Official Gazette of the Patent Office of the publication of the trademarks FRESH-AID and FRESH-ADE, it notified plaintiff that it objected to plaintiff's use of these marks and demanded that plaintiff cease such use. Plaintiff refused. On April 13, 1959, defendant filed its petition to cancel plaintiff's registrations. In the cancellation proceeding, both plaintiff and defendant offered testimony.

On October 12, 1960, the Trademark Trial and Appeal Board, unanimously held that the concurrent use of plaintiff's FRESH-AID or FRESH-ADE and defendant's trademark FRESHIE is likely to cause purchaser confusion. The Board ordered that plaintiff's registrations of FRESH-AID and FRESH-ADE be canceled (127 U.S.P.Q. 171).

The Board stated, p. 172: "It is apparent that the goods of the parties here involved are both essentially imitation beverage bases for making soft drinks and are of such a nature that if marketed under the same or similar marks they might readily be assumed to emanate from a single source. While respondent's 'FRESH-AID' and 'FRESH-ADE' may differ slightly from petitioner's 'FRESHIE' in the suffix portions thereof, the marks are otherwise quite close in sound, appearance and suggestive connotation, and hence, purchaser confusion would be quite likely to occur."

It should be kept in mind that the instant case did not arise in the District Court. This was a Patent Office cancellation proceeding. The role of the District Court is different in this kind of proceeding than in a case where a suit involving the validity of a trademark is originally commenced in the District Court.

The case of *Esso Standard Oil Company* v. *Sun Oil Company*, 1st C. Cir., 229 F. 2d 37, points out the distinction. That suit arose in a Patent Office proceeding in which the registration of the trademark SUNVIS for lubricating oils was opposed. The Patent Office held the concurrent use of the two marks being considered were likely to cause confusion and registration was refused. The applicant brought suit in the District Court to review the Patent Office decision. The District Court there, as here, disagreed with the Patent Office and substituted its own findings for the crucial fact of confusing similarity. The Court of Appeals reversed saying, at page 40: ". . . In patent and trademark cases under Rev. Stat. § 4915 a finding of fact by the Patent Office as to priority of invention or confusing similarity of marks must be accepted as controlling, unless the contrary is established by evidence 'which, in character and amount carries through conviction.' *Morgan* v. *Daniels*, 1894, 153 U.S. 120, 125 (citing additional cases). As we pointed out in *Abbot* v. *Coe*, 1939, . . . 109 F. 2d 449, 451, a mere preponderance of the evidence is not sufficient with regard to invention; the Patent Office finding must be accepted if it is 'consistent with evidence,' the Patent Office being an expert body pre-eminently qualified to determine questions of this kind."

In *Yale Electric Corporation* v. *Robertson*, 26 F. 2d 972, the Court, speaking through Judge Learned Hand, said, page 973: "The District Judge took more testimony, and also reached the conclusion that there was likelihood of confusion. As the case came up, he was, and we are, required to accept the findings of the Patent Office on such an issue of fact, unless the evidence to the contrary is altogether convincing . . . for the new evidence was not of a kind to change the result."

We have held the likelihood of confusion is a question of fact. *G. D. Searle & Co.* v. *Chas. Pfizer & Co., Inc.*, 231 F. 2d 316, 318; *Albert Dickinson Co.* v. *Mellos Peanut Co. of Illinois*, 179 F. 2d 265, 269-270.

We have also held a trademark is confusingly similar to a prior trademark if it is similar in sound, appearance, or suggestive connotation. *Independent Nail & Packing Co., Inc. v. Stronghold Screw Products, Inc.*, 205 F. 2d 921, 924; *Northam Warren Corporation v. Universal Cosmetic Co.*, 18 F. 2d 774, 775.

The cases above cited from this Court are also authority for the rule that evidence of actual confusion is not necessary to a finding of likelihood of confusion.

We have stressed on numerous occasions that one entering a field already occupied by another has a duty to select a trademark that will avoid confusion. Thus, in *Northam Warren Corporation v. Universal Cosmetic Co., supra*, we said, at page 775: "One entering a field of endeavor already occupied by another should, in the selection of a trade-name or trade-mark, keep far enough away to avoid all possible confusion."

The District Court held that Frusum is descriptive of defendant's beverage base product and, therefore, not entitled to protection. Apparently the Court overlooked the distinction between suggestive and descriptive trademarks. In *Independent Nail & Packing Co., Inc. v. Stronghold Screw Products, Inc.*, 205 F. 2d 921, 925, we said: "However, a trademark may consist of a word or words suggestive of the character of the goods or the properties which the owner of the mark wishes the public to attribute to them, such as 'Holeproof', *Holeproof Hosiery Co. v. Wallach Bros.*, C.C., 172 F. 859, and be valid."

Plaintiff relies on such cases as *Skinner Mfg. Co. v. Kellogg Sales Co.*, 8 Cir., 143 F. 2d 895; and *Kellogg Company v. National Biscuit Company*, 305 U.S. 111. In the *Skinner* case, the term "Raisin Bran" was held descriptive of cereal made with raisins and bran. In the *National Biscuit Company* case, the term "Shredded Wheat" was held descriptive of a cereal made of wheat which had been shredded. We agree with these decisions, but they are not authority for holding Frusum to be descriptive of a beverage base any more than they were

authority for holding "Stronghold" to be descriptive of a nail.

In order to support its contention that confusion is not likely, plaintiff relies on the holding of the District Court that FRESHIE had not acquired a secondary meaning. This argument ignores the fact that a suggestive mark such as FRESHIE, as opposed to a wholly descriptive mark, is entitled to protection without secondary meaning being proved. As was said in *Huntington Laboratories, Inc. v. Onyx Oil & Chemical Co.* (C.C.P.A. 1948), 165 F. 2d 454: " . . . [I]t has never been deemed necessary in order to establish the validity of a suggestive mark to show that it had a secondary meaning."

The judgment of the District Court is reversed and this cause is remanded with instructions to dismiss the complaint and to enjoin plaintiff from its wrongful use of FRESH-AID.

Under the circumstances of this case, an accounting will not be ordered.

REVERSED.

APPENDIX B.

Decision of District Court Findings of Fact and Conclusions of Law.

IN THE UNITED STATES DISTRICT COURT

(Caption—60 C 1846)

Before Judge Fred L. Wham
Tuesday, January 30, 1962
10:00 o'clock a. m.

Trial resumed pursuant to adjournment.

Present:

Same as before.

The Clerk: No. 60 C 1846, Watkins Products, Inc., vs. Sunway Fruit Products, Inc.

Mr. Hofstetter: Good morning, your Honor.

The Court: Good morning.

Mr. Miller: Good morning, your Honor.

The Court: Good morning.

I am ready to dispose of this case.

MEMORANDUM OF DECISION.

By its complaint, plaintiff and counter-defendant, Watkins, a Minnesota corporation, seeks a review of a decision of the Trade-Mark Trial and Appeal Board of the United States Patent Office handed down in a cancellation proceeding brought by the defendant and counter-claimant, Sunway, a corporation of Illinois, to secure the cancellation of Watkins' trade-mark "FRESH-AID" registered in the Patent Office on January 1, 1959, and given No. 672,986.

In said proceedings, Sunway was successful, and Watkins' trade-mark "FRESH-AID" was ordered cancelled. Watkins seeks to have said decision and order set aside, and its trade-mark ordered restored to the register.

Sunway's trade-mark "FRESHIE" has been continuously used and applied to Sunway's product, a powdered imitation beverage base of many flavors, by Sunway and its assignor, or predecessor, since 1944, and has been registered in the Patent Office since November 24, 1953, the registration number being 582,763.

The Patent Office Trial and Appeal Board, in its opinion after reciting its findings, explained its holding, as follows, quoting from the decision:

> "It is apparent that the goods of the parties here involved are both essentially imitation beverage bases for making soft drinks and are of such a nature that if marketed under the same or similar marks, they might readily be assumed to emanate from a single source. While respondent's "FRESH-AID" and "FRESH-ADE" may differ slightly from petitioner's "FRESHIE" in the suffix portions thereof, the marks are otherwise quite close in sound, appearance and suggestive connotation, and hence, purchaser confusion would be quite likely to occur.
>
> "On the basis thereof, it is concluded that respondent was not entitled to register either of its marks at the time of filing its application therefor.
>
> "Decision.
>
> "The petition is granted; and registrations Nos. 672,986, and 673,676, will be cancelled in due course."

Sunway's answer to the complaint requests a dismissal of the complaint as being without merit. Sunway also filed a counter-claim charging Watkins with infringement of its trade-mark "FRESHIE" after notice; also charging unfair competition, unjust enrichment, and dilution of Sunway's trade-mark and good will secured through advertising.

Watkins, by its reply, denied all material allegations of the counter-claim.

The evidence before this court required two full days for the testimony, reception of exhibits, and argument. In

my view, there was evidence before this court that was not produced before the Trade-Mark Trial and Appeal Board that was material.

Before the Appeal Board and before this court, it appeared that the basic issue was identical, namely, "Is Watkins' trade-mark "FRESH-AID" for a liquid imitation base for soft drinks confusingly similar to Sunway's trade-mark "FRESHIE" for a powdered imitation base for soft drinks."

As noted above, the Appeal Board held it to be confusingly similar and ordered the registration cancelled. For reasons that will appear later, this court is convinced that said finding on said basic issue was erroneous. Under the evidence before the Appeal Board, and certainly under the evidence before this court, the evidence, as a whole, clearly sustains the complaint, and this court holds in favor of Watkins and grants the relief sought in the complaint, with costs. Necessarily, in view of the holding just announced by this court, the counter-claim must be and is dismissed.

Aside from the common use in the two trade-marks of the descriptive and generic word "fresh", I find very slight similarity between the marks as applied to an imitation beverage base, whether liquid or powdered. As shown by the evidence, the word "fresh", which is clearly descriptive of state or quality, and in no way indicates the source of a product on which it may be used as part of a trade-mark, has been registered as part of numerous trade-marks applying to a considerable number and variety of drinks, foods and food products. Neither reason, nor the law as I understand it, will permit Sunway to pre-empt to itself all trade-mark use of the word "fresh" as applied to beverage-base products to the exclusion of another having beverage-base products for sale, unless the later trade-mark adopted by such other is so confusingly similar as to indicate the likelihood of confusion as to the source of the product.

It is because I find no such similarity between the trade-marks of Sunway and Watkins here in controversy, that I hold the Watkins trade-mark valid and not infringing.

The suffix used by Sunway is made up of the letters "ie" and combined with "fresh" makes up the single word "FRESHIE". The suffix "ie" forms the single word "FRESHIE" by being added to the word "fresh", seems to be a diminutive form or in the nature of a diminutive form; that in common usage, at least, hints at an effort to appeal to children or to the mothers of children, or to, perhaps, the gay young people seeking refreshment by way of soft drinks.

Watkins' trade-mark, "FRESH-AID" had a full-word "aid" attached to the full word "fresh" by a hyphen, forming a compound word. "Aid" has no similarity to the suffix "ie", used by Sunway, and has no connotation or pronunciation which could be confusingly similar to "FRESHIE".

I find that there is no confusing similarity between the marks in appearance, sound or meaning, and certainly there is nothing about the marks which could reasonably be said to cause confusion as to the source of the products or the likelihood of such confusion.

The evidence does not show that "FRESHIE" has acquired a secondary meaning. It is conceded that no actual confusion has been shown. I find that no likelihood of confusion has been shown or appears from the evidence. In fact, the contrary appears.

The evidence shows that at all times since Watkins has used its mark "FRESH-AID" in advertising or sales, it has preceded the trade-mark by the name "Watkins," which would seem to foreclose any likelihood of confusion as to the source of "FRESH-AID". This is important in connection with the counter-claim.

In the display of Sunway's powdered products in opaque packages, colored according to flavor, bearing its trade-mark "FRESHIE", and the display of Watkins' liquid

concentrate, colored according to flavor, and contained in comparatively large, flat, transparent bottles bearing labels reciting "Watkins FRESH-AID", there seems to be no similarity or reasonable cause for or likelihood of confusion.

In view of all I have said, I have necessarily rendered judgment for the plaintiff and for the relief prayed in the complaint, with costs.

The counter-claim is dismissed.

FINDINGS OF FACT.

1. Plaintiff and counter-defendant, Watkins Products, Inc. hereinafter for brevity called Watkins, is a corporation of Minnesota, located at Winona, Minnesota, formerly known by the corporate name of The J. R. Watkins Company.

2. Defendant and counter-claimant, Sunway Fruit Products, Inc. hereinafter for brevity called Sunway, is a corporation of Illinois, located at 314 West Institute Place, Chicago, Illinois, within the Northern District, Eastern Division of Illinois.

3. On January 20, 1959, Watkins obtained U. S. trademark registration No. 672,986 on the Supplemental Register for the trademark "FRESH-AID" for beverage base for soft drinks, in the U. S. Patent Office.

4. Sunway, as prior user and owner of U. S. trademark registration No. 582,763 of the trademark "FRESHIE" also upon beverage bases for soft drinks, instituted a cancellation proceeding in the U. S. Patent Office as Cancellation Petition No. 7,293, Sunway Fruit Products, Inc. *vs.* The J. R. Watkins Company, to cancel said registration No. 672,986, Sunway claiming that the trademark "FRESH-AID" registered to Watkins was confusingly similar to Sunway's prior registered trademark "FRESHIE".

5. On October 12, 1960, the Trademark Trial and Appeal Board of the U. S. Patent Office sustained the petition to cancel by erroneously finding that the marks "FRESH-AID" of Watkins and "FRESHIE" of Sunway, except for slight differences in their suffixes "are otherwise quite close in sound, appearance and suggestive connotation and hence, purchaser confusion would be quite likely to occur" and thereupon said board ordered cancellation of Watkins aforesaid registration on the Supplemental Register No. 672,986 for the trademark "FRESH-AID".

6. The priority of Sunway in use of its mark "FRESHIE" is not disputed, it having used said mark, by itself or its predecessors, since July, 1944 and Watkins having used its "FRESH-AID" mark since November 18, 1957.

7. In seeking cancellation of Watkins' "FRESH-AID" registration by the Trademark Trial and Appeal Board, Sunway represented to said board that "FRESHIE and FRESH stimulate an identical mental association".

8. The Trademark Trial and Appeal Board in its decision made no finding that the trademark "FRESHIE" had acquired a secondary meaning or had become distinctive of Sunway's beverage base as a source indication rather than as descriptively of the goods.

9. The word "fresh" in various combinations is used and registered widely for foods and beverage products, including beverage bases, and the ordinary purchaser is not likely to attribute new and different trademarks to the source of a previous product merely because such trademarks include the word "fresh" in such common use since he is aware that many use the mark and he will hesitate to attribute it to any particular source.

10. The word "fresh" in itself is generically descriptive of the nature and quality of the goods, beverage bases, here involved, and is and has been in common use as part of numerous registered trademarks in the food and beverage field in the same generically descriptive manner as here.

11. The evidence on behalf of Sunway did not include any actual specimen of any newspaper advertisement of its "FRESHIE" trademark prior to 1957 when Watkins nominally entered the field with its "FRESH-AID" product although there was testimony that in 1948 many years prior to such advent there had been some "FRESHIE" ads including one in the comic section of the Chicago American and in certain other newspapers in different states. Sunway also did a small amount of radio advertising of "FRESHIE" in Minnesota just prior to adoption of "FRESH-AID" by Watkins. The advertising of "FRESHIE" was otherwise nominal and according to Sunway's Executive Vice President was purposely so because they wanted to crawl before they walked. The sales of "FRESHIE" started to diminish in 1949 many years prior to 1958 when Watkins "FRESH-AID" product entered the field commercially and the downward trend of such sales continued with slight variations up to the present time obviously due to causes other than competition from Watkins. Many important customers of Sunway for its "FRESHIE" product were lost long before the appearance of Watkins "FRESH-AID" in the market and many were sold considerable quantities during one season many years ago long prior to 1957 but were not sold since. It was obvious that according to the evidence no secondary meaning had been acquired by Sunway in its "FRESHIE" trademark as a source indication.

12. No actual confusion was found to exist between the marks "FRESH-AID" and "FRESHIE" here involved and none appeared likely.

13. The suffix used by Sunway is made up of the letters "ie" and combined with "fresh" makes up the single word "FRESHIE". The suffix "ie" forms the single word "FRESHIE" by being added to the word "fresh", seems to be a diminutive form or in the nature of a diminutive form; that in common usage, at least, hints at an effort to appeal to children or to the mothers of children, or to, perhaps, the gay young people seeking refreshment by way of soft drinks.

14. Watkins' trade-mark "FRESH-AID" has a full word "aid" attached to the full word "fresh" by a hyphen, forming a compound word. "Aid" has no similarity to the suffix "ie", used by Sunway, and has no connotation or pronunciation which could be confusingly similar to "FRESHIE".

15. There is no confusing similarity between the marks in appearance, sound or meaning and there is nothing about the marks which could reasonably be said to cause confusion as to the source of the products or the likelihood of confusion. In fact the contrary appears.

16. The evidence shows that at all times since Watkins has used its mark "FRESH-AID" in advertising or sales, it has preceded the trade-mark by the name "WATKINS," which would seem to foreclose any likelihood of confusion as to the source of "FRESH-AID." This is important in connection with the counter-claim.

17. In the display of Sunway's powdered products in opaque packages, colored according to flavor, bearing its trade-mark "FRESHIE," and the display of Watkins' liquid concentrate, colored according to flavor, and contained in comparatively large, flat, transparent bottles bearing labels reciting "WATKINS FRESH-AID," there seems to be no similarity or reasonable cause or likelihood of confusion.

CONCLUSIONS OF LAW.

1. Watkins "FRESH-AID" registration here involved, being on the Supplemental Register was by virtue of being on the Supplemental Register admittedly descriptive of its liquid beverage base.

2. Sunway's mark "FRESHIE" although registered on the Principal Register was and is nevertheless descriptive of its powdered beverage base and although its right of use of its mark may have become incontestable under Section 1065 of 15 USC (The Trademark Act of 1946) its rights therein as an offensive weapon have not been

broadened because of such incontestability. A court's consideration of the descriptive character of the mark is not precluded and the assumption of validity thereof as an offensive weapon can be easily overcome where a secondary meaning has not been established. *John Morrell & Co.* v. *Reliable Packing Co.* (7th Cir. Oct. 18, 1961) 295 F. 2d 314, 316.

3. The Trademark Trial and Appeal Board in its decision as to confusing similarity of the marks "FRESH-AID" and "FRESHIE" made no finding that the latter had acquired a secondary meaning or had become distinctive as a source indication and it is presumed that the mark "FRESHIE" had not acquired that status.

4. The Trademark Trial and Appeal Board in determining the question of confusion between the marks hereinvolved failed to take into consideration the inherent weakness of Sunway's mark "FRESHIE" as including the generic word "FRESH" in common use descriptively, as a part of trademarks and widely used in the food and beverage fields in the same generically descriptive manner and instead said board treated the mark "FRESHIE" as if it were an arbitrary and naturally distinctive mark in its comparison of same with Watkins "FRESH-AID" mark contrary to the doctrine of logic and of law expressed in the case of *Solventol Chemical Products Inc.* v. *Langfield* 134 F. 2d 899 and others hereinafter referred to, holding that descriptive portions of marks, especially in common use, are given relatively little weight on the question of confusion.

5. The Trademark Trial and Appeal Board in determining the question of confusion between the marks hereinvolved, failed to take into consideration the fact that aside from the common generically descriptive portion "FRESH" the suffixes of the marks "AID" of "FRESH-AID" and "IE" of "FRESHIE" differed in appearance, sound and meaning as it was required by logic and law to do. *Solventol Chemical Products, Inc.* v. *Langfield*, 134 F. 2d 899 (Solventol and Solvite); *Aluminone Corpora-*

tion v. *Vita-Var Corporation*, 183 F. 2d 612 (Alumatone and Alumikote); *Kraft Walker Cheese Co.* v. *Kingsland*, 75 F. Supp. 105, 75 USPQ 318 (Vegemite and Vegex); *Miles Laboratories, Inc.* v. *Foley & Co.*, 32 C.C.P.A. (Patents) 714, 144 F. 2d 888, 63 USPQ 64 (Vitamiles and Vitabuild); *Steem-Electric Corp.* v. *Herzfeld-Phillipson Co.*, 118 F. 2d 122, 48 USPQ 92 (Steam-O-Matic and Steam-Electric); *Vick Chemical Co.* v. *Kerfoot & Co., Ltd.*, 23 C.C.P.A. (Patents) 752, 80 F. 2d 73, 27 USPQ 393 (Vapex and Vaporub); *Thomas Kerfoot & Co., Ltd.* v. *Louis K. Liggett Co.*, 67 F. 2d 214, 21 USPQ 503 (Vapure and Vapex).

6. The large number of third party registrations of "FRESH" trademarks are relevant not only to show weakness of SUNWAY'S mark "FRESHIE" but to show lack of secondary meaning of said mark. *Shoe Corp. of America* v. *Juvenile Shoe Corp.* (U. S. Court of Customs and Patent Appeals, 1959) 266 F. 2d 793; *National Motor Bearing Co.* v. *James-Pond-Clark* (U. S. Court of Customs and Patent Appeals 1959) 266 F. 2d 799; *Seven-Up Co.* v. *Essential Products Co.* (Comr. Pats. 1954) 101 USPQ 87, 88; *Huntington Laboratories Inc.* v. *Onyx Oil and Chemical Co.*, 76 USPQ 319 (C. C. P. A. 1948); *Rogers-Peet Company* v. *The Black Manufacturing Co.*, 100 USPQ 32 (Comr. Pats. 1953).

7. The fact that WATKINS knew of SUNWAY'S registration for "FRESHIE" as a result of a search report before adopting its "FRESH-AID" trademark is immaterial because it had the right to describe its goods and use the term in combination with another term. *Miles Laboratories Inc.* v. *The Pepsodent Company* (C. C. P. A.) 104 F. 2d 205.

8. Where the decision of the Trademark Trial and Appeal Board of the Patent Office was manifestly wrong a court has no hesitancy in reversing such decision. *Solventol Chemical Products, Inc.* v. *Langfield* (6th Cir. 1943) 134 F. 2d 899; *Lauritzen Company Inc.* v. *The Borden Company* (C. C. P. A. 1956) 239 F. 2d 405; *Miles Labora-*

tories v. *Foley & Co.* (C. C. P. A. 1944) 144 F. 2d 888; *North Star Mfg. Co.* v. *Wells Lamont Corp.* (C. C. P. A. 1951) 193 F. 2d 204; *Franco-Italian Packing Corp.* v. *Van Camp Sea Food Co.* (C. C. P. A. 1944) 142 F. 2d 274; *Alumatone Corp.* v. *Vita-Var Corp.* (C. C. P. A. 1950) 183 F. 2d 612.

9. The trademark "FRESH-AID" of WATKINS not being confusingly similar to the trademark "FRESHIE" of SUNWAY, Reg. No. 672,986 of the former on the Supplemental Register is valid and said registration should be restored and the decision of the Trademark Trial and Appeal Board cancelling said registration should be reversed.

10. The file history of the application on which the trademark "FRESHIE" was granted contains no evidence of the acquisition of a secondary meaning in the mark at that time, the evidence in the proceeding before the Trademark Trial and Appeal Board does not indicate that a secondary meaning had been acquired in said mark and the additional evidence in the proceeding in this Court which was not before the Trademark Trial and Appeal Board negatives the acquisition of a secondary meaning in the mark both in its entirety and in the "FRESH" portion thereof, as a source indication.

11. Neither reason nor law will permit SUNWAY to preempt to itself all trade-mark use of the word "FRESH" as applied to beverage-base products for sale unless the later trade-mark adopted by such other is so confusingly similar as to indicate the likelihood of confusion as to source and no such similarity exists between the marks hereinvolved, the only similarity in the marks being common use of the descriptive and generic word "fresh" which is descriptive of state or quality as applied to said products and which has been registered as a part of numerous trade-marks applied to a considerable number and variety of drinks and food products.

12. There having been no secondary meaning acquired in "FRESHIE" as a source indication, no likelihood of confusion therewith by "FRESH-AID", there can be no trademark infringement, unfair competition, unjust enrichment or dilution and the counter-claim should be dismissed.

Fred L. Wham,
Judge U. S. District Court.

Signed: January 31, 1962.

APPENDIX C

Decision of Trademark Trial and Appeal Board

(127 U. S. P. Q. 171)

Patent Office Trademark Trial and Appeal Board.

SUNWAY FRUIT PRODUCTS, INC. v. THE J. R. WATKINS COMPANY.

Decided Oct. 12, 1960.

Trademark cancellation No. 7,293 by Sunway Fruit Products, Inc., against The J. R. Watkins Company, Registration Nos. 672,986, issued Jan. 20, 1959, and 673,676, issued Feb. 3, 1959. Petition granted.

Before LEACH, LEFKOWITZ, and SHEYOCK, Members.

SHEYOCK, Member.

A petition has been filed to cancel Supplemental Registrations issued to The J. R. Watkins Company, of the marks "FRESH-AID" and "FRESH AID", both for a beverage base for soft drinks.

Petitioner is Sunway Fruit Products, Inc., registrant of "FRESHIE" for a non-alcoholic, maltless, flavored concentrate used in mixing alcoholic and non-alcoholic drinks.

According to the record, petitioner, through a predecessor in title, has, since 1944, continuously manufactured and distributed a powdered beverage base for making a variety of imitation flavored drinks under the mark "FRESHIE". This product is sold to the consumer either by retail grocery stores and the like or by house-to-house sales there-

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1. Reg. No. 672,986 issued Jan. 20, 1959 on an application filed Dec. 9, 1957.

2. Reg. No. 673,676 issued Feb. 3, 1959 on an application filed ..... 25, 1957.

3. Reg. No. 582,763 issued ..... 24, 1953.

of by coffee and tea companies. The majority of petitioner's advertising is by means of direct promotion to wholesalers and retail distributors, and point of purchase displays. Petitioner's sales have varied from $306,000 in the fiscal year 1944 to $22,000 in fiscal year 1958.

Respondent is a large organization engaged in the marketing of a long line of many diversified products such as cosmetics, foods, insecticides, and medicines. There is testimony that respondent has, since the latter part of 1957, continuously marketed a liquid beverage concentrate in various imitation flavors primarily for use in making soft drinks under the mark "FRESH-ADE". This product, along with respondent's other products, has nationwide distribution through approximately 4,000 independent rural dealers and 450 independent distributors in the principal cities of the United States who, either directly or indirectly, market respondent's products by house-to-house sales thereof. Respondent's sales of "FRESH-ADE" during the past two years have been in excess of $700,000 per year. Respondent advertises its "FRESH-ADE" beverage base through such media as color advertisements in magazines of nationwide circulation, recipe folders, bulletins to dealers and distributors and point of purchase advertisements and/or display cards, and during the past two years, its advertising costs for this period have exceeded $50,000 per year.

As to the mark "FRESH-ADE", it is admitted in respondent's testimony that it has never used this mark on its goods.

Both of respondent's registrations issued on the Supplemental register. Section 24 of the Statute provides that (127 U. S. P. Q. 172)

a Supplemental Registration shall be cancelled by the Commissioner if it is found after a hearing before the Board that the registrant was not entitled to register the mark at the time of its application for registration thereof, or that the mark is not used by the registrant or has been abandoned.

It is apparent that the goods of the parties here involved are both essentially imitation beverage bases for making soft drinks and are of such a nature that if marketed under the same or similar marks they might readily be assumed to emanate from a single source. While respondent's "FRESH-ADE" and "FRESH-ADE" may differ slightly from petitioner's "FRESHIE" in the suffix portions thereof, the marks are otherwise quite close in sound, appearance and suggestive connotation, and hence purchaser confusion would be quite likely to occur.

On basis thereof, it is concluded that respondent was not entitled to register either of its marks at the time of filing its applications therefor.

Decision.

The petition is granted; and Registrations Nos. 673,986 and 673,676 will be canceled in due course.

APPENDIX D.

Judgment of C.A. 7th Cir.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago 10, Illinois

Friday, December 14, 1962

Before

Hon. F. Ryan Duffy, Circuit Judge

Hon. Latham Castle, Circuit Judge

Hon. Luther M. Swygert, Circuit Judge

WATKINS PRODUCTS, INC., formerly known as THE J. R. WATKINS COMPANY,
Plaintiff-Appellee,
vs.
SUNWAY FRUIT PRODUCTS, INC.,
Defendant-Appellant.

No. 13736

Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

This cause came on to be heard on the transcript of the record from the United States District Court for the Northern District of Illinois, Eastern Division, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this court that the judgment of the same District Court in this cause appealed from be, and the same is hereby, Reversed, with costs, and that this cause be, and it is hereby, Remanded to the said District Court with instructions to dismiss the complaint and to enjoin plaintiff from its wrongful use of FRESH-AID, in accordance with the opinion of this Court filed this day.

APPENDIX E.

Order Denying Petition for Rehearing.

UNITED STATES COURT OF APPEALS
For the Seventh Circuit
Chicago 10, Illinois

Monday, February 4, 1963

Before

Hon. F. Ryan Duffy, Circuit Judge

Hon. Latham Castle, Circuit Judge

Hon. Luther M. Swygert, Circuit Judge

WATKINS PRODUCTS, INC., ETC., *Plaintiff-Appellee,* vs. SUNWAY FRUIT PRODUCTS, INC., *Defendant-Appellant.*	Appeal from the United States District Court for the Northern District of Illinois, Eastern Division.

No. 13736

It Is Ordered by the Court that the petition for rehearing in the above entitled cause be, and the same is hereby Denied.

APPENDIX F.

Alternative Motion to Vacate Stay of Mandate.

Defendant-Appellant, Sunway Fruit Products, Inc., hereby moves the Court to vacate its stay of mandate in this action, granted on February 7, 1963, or, in the alternative, to impose certain conditions on the granting of the stay. Plaintiff's Motion For Stay Of Mandate was filed on February 6, 1963, and served by mail upon defendant on that date. Defendant did not receive the motion until the following day and, thus, had no opportunity to oppose the granting of the Motion.

As grounds in support of this motion, defendant states that the beverage base business is a seasonal business, and that most of the year's shipments are made to retailers in March and April for sale to consumers during the summer months. The stay of mandate granted to plaintiff, unless vacated, will have the effect of permitting plaintiff to enjoy another season of distribution and sale of a beverage base product under its infringing trademark. If plaintiff files its petition for a writ of certiorari by March 11, 1963, the stay of mandate would extend until the Supreme Court grants or denies the petition, probably sometime in May. This continued use by plaintiff of a confusingly similar trademark through another season's distribution would be unjust to defendant and would unjustly enrich plaintiff with profits derived from the wrongful use of the infringing trademark.

In the alternative to vacating the stay order, defendant moves that the granting of the stay of mandate be conditioned upon plaintiff being required to account for and pay over to defendant all profits derived from the sale of beverage base under the infringing trademark during the pendency of the stay order if the Supreme Court denies plaintiff's petition for a writ of certiorari. This alternative relief would provide defendant with sufficient

protection from plaintiff's continued use of the infringing trademark through another beverage base season of distribution. Meanwhile it affords plaintiff the opportunity to continue using the infringing trademark without liability if the Supreme Court should grant plaintiff's petition for a writ of certiorari.

Woodson, Pattishall & Garner
By /s/ W. Thomas Hofstetter
W. Thomas Hofstetter
2430 Prudential Plaza
Chicago 1, Illinois

Date: February 8, 1963

APPENDIX G.

Opposition of Plaintiff-Appellee to Proposed Order Conditioning Continuation of Stay on Accounting for Profits if Certiorari not Granted.

Plaintiff-Appellee objects to the order of February 12, 1963, directing the preparation of a proposed order conditioning the continuance of the stay of mandate upon plaintiff-appellee accounting for its profits from the sale of its goods under the trade-mark "FRESH-AID" or "FRESH-AIDE" during the pendency of the stay if the United States Supreme Court denies the petition for certiorari. The grounds for objections are as follows:

(1) The factual basis for the motion for imposing such condition was not verified as required by Rule 22(c) of this Court.

(2) The condition imposed injects a factor upon plaintiff-appellee which interferes with its free exercise of its right to seek a review by the Supreme Court and which is inconsistent with the decision of this Court which was obviously predicated upon the fact that defendant-appellant was not damaged by the use of "FRESH-AID".

(3) Defendant-appellant has known of the use of plaintiff-appellee's mark since February, 1959 (Defs. Appendix 38) and did not seek an injunction until they filed a counter-claim to plaintiff-appellee's action on December 21, 1960 (Defs. App. 13). Defendant-appellant obviously would not be prejudiced by another few weeks or even months of use of the mark hereinvolved.

/s/ Theodore W. Miller
Theodore W. Miller
Attorney for Plaintiff-Appellee

APPENDIX H.

Order of C. A. 7th Cir. of February 20, 1963.

On consideration of the motion of defendant-appellant,

It Is Ordered that defendant-appellant's Motion To Vacate Stay Of Mandate be denied, and that, as a condition for the continuance of the stay of mandate, plaintiff-appellee shall be and hereby is required to account for and pay over to defendant-appellant all profits derived from the sale of beverage base under the trademarks FRESH-AID or FRESH-ADE during the pendency of the stay order entered February 7, 1963, if the United States Supreme Court denies plaintiff-appellee's petition for a writ of *certorari*.

/s/. F. Ryan Duffy
Circuit Judge

Dated: February 20, 1963

APPENDIX I.

Statutes Involved.

15 U.S.C. § 1071. *Appeal to courts; review; election of remedies; Commissioner as party.*

"Any applicant for registration of a mark, party to an interference proceeding, party to an opposition proceeding, party to an application to register as a lawful concurrent user, party to a cancelation proceeding, or any registrant who has filed an affidavit as provided in section 1058 of this title, who is dissatisfied with the decision of the Commissioner or the Trademark Trial and Appeal Board, may appeal to the United States Court of Customs and Patent Appeals or may proceed under sections 145 and 146 of Title 35, as in the case of applicants for patents, under the same conditions, rules, and procedure as are prescribed in the case of patent appeals or proceedings so far as they are applicable: *Provided*, That any party who is satisfied with the decision of the Trademark Trial and Appeal Board shall, upon the filing of an appeal to the Court of Customs and Patent Appeals by any dissatisfied party, have the right to elect to have all further proceedings under section 146 if Title 35, by election as provided in section 141 of Title 35. The Commissioner of Patents shall not be a necessary party to an interpartes proceeding under section 146 of Title 35, but he shall be notified of the filing of the bill by the clerk of the court in which it is filed and the Commission shall have the right to intervene in the action. As amended July 19, 1952, c. 950, §2, 66 Stat. 814; Aug. 8, 1958, Pub. L. 85-609, §1(c), 72 Stat. 540."

28 U.S.C. § 1254. *Courts of appeals; certiorari; appeal; certified questions.*

"Cases in the courts of appeals may be reviewed by the Supreme Court by the following methods:

(1) By writ of certiorari granted upon the petition of any party to any civil or criminal case, before or after rendition of judgment of decree; • • •"

28 U.S.C. § 2072. *Rules of civil procedure for district courts.*

"The Supreme Court shall have the power to prescribe, by general rules, the forms of process, writs, pleadings, and motions, and the practice and procedure of the district courts of the United States in civil actions.

Such rules shall not abridge, enlarge or modify any substantive right and shall preserve the right of trial by jury as at common law and as declared by the Seventh Amendment of the Constitution.

Such rules shall not take effect until they have been reported to Congress by the Chief Justice at or after the beginning of a regular session thereof but not later than the first day of May, and until the expiration of ninety days after they have been thus reported.

All laws in conflict with such rules shall be of no further force or effect after such rules have taken effect. Nothing in this title, anything therein to the contrary notwithstanding, shall in any way limit, supersede, or repeal any such rules heretofore prescribed by the Supreme Court. • • •"

28 U.S.C. § 2101. *Supreme Court; time for appeal or certiorari; docketing; stay.*

"(c) Any other appeal or any writ of certiorari intended to bring any judgment or decree in a civil action, suit or proceeding before the Supreme Court for review shall be taken or applied for within ninety days after the entry of such judgment or decree. A Justice of the Supreme Court, for good cause shown, may extend the time for applying for a writ of certiorari for a period not exceeding sixty days."

28 U.S.C. § 2106. *Determination.*

"The Supreme Court or any other court of appellate jurisdiction may affirm, modify, vacate, set aside or reverse any judgment, decree, or order of a court lawfully brought before it for review, and may remand the cause and direct the entry of such appropriate judgment, decree, or order, or require such further proceedings to be had as may be just under the circumstances. June 25, 1948, c. 646, 62 Stat. 963."

28 U.S.C. Rule 52. *Findings by the Court.*

(a) *Effect.* In all actions tried upon the facts without a jury or with an advisory jury, the Court shall find the facts specially and state separately its conclusions of law thereon and direct the entry of the appropriate judgment; and in granting or refusing interlocutory injunctions the court shall similarly set forth the findings of fact and conclusions of law which constitute the grounds of its action. Requests for findings are not necessary for purposes of review. Findings of fact shall not be set aside unless clearly erroneous, and due regard shall be given to the opportunity of the trial court to judge of the credibility of the witnesses. The findings of a master, to the extent that the court adopts them, shall be considered as the findings of the court. If an opinion or memorandum of decision is filed, it will be sufficient if the findings of fact and conclusions of law appear therein. Findings of fact and conclusions of law are unnecessary on decisions of motions under Rules 12 or 56 or any other motion except as provided in Rule 41(b). As amended December 27, 1946, effective March 19, 1948."

35 U.S.C. § 146. *Civil action in case of interference.*

"Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided

in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. July 19, 1952, c. 950, § 1, 66 Stat. 803.